

APPLICANT(S): PAISS, Omry  
SERIAL NO.: 10/026,678  
FILED: December 27, 2001  
Page 8

### REMARKS

The present Amendment is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims are respectfully requested.

### Status of Claims

Claims 1-20 are pending in the application. Claim 1 has been amended.

Applicant respectfully asserts that the amendments to claim 1 and the specification add no new matter.

### Remarks to the Specification

The Office Action objected to the specification as not including a "Summary of the Invention" section and required Applicant to amend the patent application to include such a section. Applicant hereby respectfully traverses the objection and kindly points out to the Examiner that a "Summary of the Invention" section is optional since neither the rules nor the patent statute requires a patent applicant to provide such summary. As discussed in 37 CFR 1.73:

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, *should* precede the detailed description. Such summary *should, when set forth*, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed [emphasis added]. 37 CFR 1.73.

Thus, Applicant respectfully points out that the use of the word "should" and the phrase "when set forth" indicates that inclusion of a "Summary of the Invention" section is optional rather than mandatory. As a result, it is believed there is no legal basis upon which to

APPLICANT(S): PAISS, Omry  
SERIAL NO.: 10/026,678  
FILED: December 27, 2001  
Page 9

require a patent applicant to provide a "Summary of the Invention" section in a patent application or to require an applicant to amend the patent application to include such a summary. Therefore, the objection and any requirement related thereto should be withdrawn

#### **Drawings Rejections**

The drawings have been objected to as failing to comply with 37 CFR 1.84(p)(5) because they include in FIG. 3 a reference character 516 not mention in the description. Applicant has amended the paragraph beginning on page 9, line 29 and ending on page 10 line 15 to include element 516 of FIG. 3. Therefore, this rejection is now moot.

The drawings have been objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters 535 and 536 have both been used to designate "playing the download conversation". Applicant has amended the paragraph on page 11, lines 5-13 to overcome this rejection. Therefore, this rejection is now moot.

It is respectfully submitted that the above amendments are made merely to correct obvious typographical errors. Applicant respectfully submits that no new matter has been added by this amendment.

APPLICANT(S): PAISS, Omry  
SERIAL NO.: 10/026,678  
FILED: December 27, 2001  
Page 10

## CLAIM REJECTIONS

### 35 U.S.C. § 112 Rejections

In the Office Action, the Examiner rejected claim 5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has been amended to overcome the antecedent basis deficiencies in claim 5, as noted by the Examiner. It is respectfully asserted that the foregoing amendment merely addresses matters of form and does not change the literal scope of the claim in any way or result in any prosecution history estoppel.

Applicant respectfully asserts that this amendment renders both claims 1 and 5 proper under 35 USC 112, and request that the rejection be withdrawn.

### 35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1-8 and 10-20 under 35 U.S.C. § 102(e), as being anticipated by Barak et al. (US 6,792,093). Applicant respectfully traverses this rejection in view of the remarks that follow.

As is well established, in order to successfully assert a *prima facie* case of anticipation, the Office Action must provide a single prior art document that includes every element and limitation of the claim or claims, presented in accordance with the claim(s) being rejected. That is, M.P.E.P § 2142 specifies that the initial burden to establish a *prima facie* showing rests with the Office Action. If the Office Action does not establish the prerequisite *prima facie* showing, Appellant is not under any obligation to rebut the rejection because per the MPEP, the rejection is improper for failure to establish a *prima facie* showing.

Specifically, Applicant would like to point out that it is improper for the Office Action to infer that a cited document inherently teaches a claim limitation when such an interpretation is not supported by the teachings of the document.

Referring to the rejections of independent claims 1, 6, 11 and 17, the Office Action suggested that the sending data packets of a recorded conversation to a subscriber, wherein a conversion recording is done by alternating between a first link and a second link of a wireless communication system is inherently implemented in the recording method of Barak et. al. and in that the call can be retrieved by the Internet as disclosed by Barak et al. Applicant respectfully asserts that persons of ordinary skill in the art are aware that recording of a conversation may be done without altering between links at either end of the conversation.

Furthermore, when relying upon a theory of inherency, the Office Action "must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." M.P.E.P. §2112 (citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)). The test of inherency is not satisfied by what a reference "may" teach. *SGS-Thomson Microelectronics, Inc. v. International Rectifier Corp.*, 32 U.S.P.Q.2d 1496, 1503 (Fed. Cir. 1994) (citing *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 U.S.P.Q.2d 1746, 1749-50 (Fed. Cir. 1991)). Rather, evidence of inherency "*must make clear* that the missing descriptive matter is necessarily present in the thing described in the reference, *and* that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d at 1268-69, 20 U.S.P.Q.2d at 1749 (emphasis added). The Office Action has not met this burden.

In addition, the Court of Appeals for the Federal Circuit has stated repeatedly that inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." 948 F.2d at 1269, 20 USPQ2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

For example, the Court of Appeals for the Federal Circuit recently reversed an Examiner's obviousness rejection that was based in part on inherency. See, In re Frank S. Glaug, 2002 U.S. App Lexis 4246 (Fed Cir. 2002). In the present case, Applicant respectfully submits that it is improper for the Office Action to infer that Barak et al. teaches

APPLICANT(S): PAISS, Omry  
SERIAL NO.: 10/026,678  
FILED: December 27, 2001  
Page 12

features that are not stated in the text and that are inconsistent with the express teachings of Barak et al. as explained above.

Accordingly, Applicant respectfully asserts that a *prima facie* case of anticipation of independent claims 1, 6, 11 and 17 by Barak et al. cannot be established, and thus independent claims 1, 6, 11 and 17 are allowable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections of independent claims 1, 6, 11 and 17.

Applicant notes that claims 1-5 depend from patentable base claim 1, claims 7 and 8 depend from patentable base claim 6, claims 12-16 patentable base claim 11 and claims 18-20 depend from patentable base claim 17. In this regard, in addition to any independent bases for patentability, Applicant respectfully submits that claims 2-5, 7-8, 12-16 and 18-20 are patentable over the cited reference by virtue of at least such dependency on patentable base claims 1, 6, 11 and 17, respectively. Accordingly, Applicant respectfully requests that the §102 rejection of claims 1-8 and 11-20 be withdrawn.

### **35 U.S.C. § 103 Rejections**

In the Office Action, the Examiner rejected claim 9 under 35 U.S.C. § 103(a), as being unpatentable over Barak et al. (US 6,792,093) in view of Liu et al. (US 6,434,139).

Applicant respectfully traverses the rejection of claims Barak et al under Liu et al.

Applicant notes that claim 9 depends from patentable base claim 6. In this regard, in addition to any independent bases for patentability, Applicant respectfully submits that claim 9 is patentable over the cited reference by virtue of at least such dependency on patentable base claim 6. Accordingly, Applicant respectfully requests that the §103 rejection of claim 9 be withdrawn.

### **Conclusion**

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

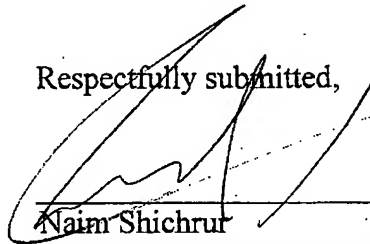
Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone

APPLICANT(S): PAISS, Omry  
SERIAL NO.: 10/026,678  
FILED: December 27, 2001  
Page 13

number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Naim Shichrur', is written over a horizontal line.

Naim Shichrur  
Attorney/Agent for Applicant(s)  
Registration No. 56,248

Dated: December 21, 2005

**Pearl Cohen Zedek Latzer, LLP**  
10 Rockefeller Plaza, Suite 1001  
New York, New York 10020  
Tel: (212) 632-3480  
Fax: (212) 632-3489